

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

1/5/01

Paper No. 31  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Matrixx Marketing, Inc.  
v.  
Matrix Alliances, Inc.

Opposition No. 101,042  
to application Serial No. 74/665,538  
filed on April 25, 1995

Gail L. Morrissey and Jeffrey S. Standley of Standley & Gilcrest  
for Matrixx Marketing, Inc.

H. Robert Henderson of Henderson & Sturm for Matrix Alliances,  
Inc.

Before Hanak, Bucher and Holtzman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Matrix Alliances, Inc. filed an application to register the  
term MATRIX ALLIANCES for "direct mail and telemarketing  
services" in International Class 35. The application is based  
upon a *bona fide* intention to use the mark in commerce.

Following publication of the mark, Matrixx Marketing, Inc.  
timely filed a notice of opposition, on the ground that  
applicant's mark so resembles opposer's previously used and  
registered marks MATRIXX MARKETING in connection with a variety  
of services including telemarketing services<sup>1</sup> and MATRIXX MARKET

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<sup>1</sup> Reg. No. 1,558,386 issued on September 26, 1989, Section 8  
affidavit accepted, Section 15 affidavit acknowledged, setting forth

WATCH in connection with a variety of services including marketing research services and conducting marketing studies for others,<sup>2</sup> both in International Class 35, as to be likely, if used in connection with applicant's telemarketing services, to cause confusion, or to cause mistake or to deceive.

In its original notice of opposition, opposer also alleged that registration of this mark will create a false connection with opposer under Section 2(a) of the Lanham Act and will result in a "tarnishment" of opposer's marks. Then under an amended Notice of Opposition, opposer charged that inasmuch as applicant's corporate status had allegedly been revoked by the State of Nevada, applicant is no longer a "person" as contemplated by the Lanham Act, and hence is not entitled to a registration under 15 U.S.C. §1057 for MATRIX ALLIANCES. However, since none of these latter three allegations were argued in opposer's brief on final decision, we presume the only remaining ground for opposition is that of likelihood of confusion under Section 2(d) of the Act.

Applicant denied the salient allegations of likelihood of confusion contained in the notice of opposition.

The record consists of the pleadings; the file of the involved application; status and title copies of opposer's two

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December 5, 1988 as the date of first use and first use in commerce. The term "MARKETING" is disclaimed apart from the mark as shown.

<sup>2</sup> Reg. No. 1,788,952 issued on August 17, 1993, setting forth July 22, 1991 as the date of first use and first use in commerce. The term "MARKET WATCH" is disclaimed apart from the mark as shown.

federal registrations and the testimony deposition of Michael T. Capizzi, opposer's vice-president of marketing and sales support, with related exhibits, all submitted under a notice of reliance. Applicant submitted no evidence or testimony. Only opposer has filed a brief and an oral hearing was not requested.

The record shows that opposer is one of the largest telephone marketing companies in the world. Opposer, a customer service outsourcing vendor, also provides telephone marketing and marketing research for its corporate clients. As one of the world's leading provider of telemarketing services, opposer promotes and sells its services to Fortune 1000 corporations based in the United States as well as to large organizations in Canada and Europe. Over a ten year period, opposer promoted its services under its MATRIX marks in national publications, at trade shows and through its own brochures and catalogs which are sent or delivered to both existing and potential corporate clients.

Applicant's principal business is in the health care and financial services field. However, this is an intent-to-use application on which no allegation of use has been filed. Hence, the record is devoid of any evidence that applicant has actually made use of the mark MATRIX ALLIANCES for direct mail and telemarketing services.

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As indicated above, opposer made of record status and title copies of its pleaded registrations for the marks MATRIXX MARKETING and MATRIXX MARKET WATCH. Thus, there is no issue with respect to opposer's priority. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to the issue of likelihood of confusion. Our determination under Section 2(d) of the Trademark Act is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to a consideration of the respective services, opposer is a well-known provider of telemarketing services. Because applicant's recital of services includes telemarketing services, we must assume the services are identical, and that they will be offered in identical channels of trade to the exact same class of purchasers.

Turning next to a consideration of the marks, we begin our analysis of whether confusion is likely by keeping in mind two propositions set forth by the Court of Appeals for the Federal Circuit. First, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Second, in articulating reasons for

reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In considering the marks before us, both parties' marks are dominated by the word "MATRIX" or "MATRIXX." Applicant's MATRIX ALLIANCES mark is clearly dominated by the word MATRIX.<sup>3</sup> By the same token, registrant's marks are dominated by the word "MATRIXX." Registrant has disclaimed exclusive rights to use the words MARKETING and MARKET WATCH, thereby acknowledging the descriptiveness of these terms. The record demonstrates that quite frequently the word MATRIXX alone is used as a source indicator for opposer's services, both by opposer itself and by third parties in referring to opposer's services. Similarly, it is safe to assume that upon applicant's introduction into the marketplace of its mark on these services, the word MATRIX alone would be used by purchasers in referring to applicant's telemarketing services.

Clearly as to sound, "Matrix" and "Matrixx" are exact phonetic equivalents. The words "MATRIX" and "MATRIXX" are also virtually identical as to appearance. Within the contest of

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<sup>3</sup> Opposer's witness also noted that in providing integrated services to its clients, it often signs "**alliance** agreements" with other service vendors.

these composite marks, it is unlikely that consumers would even notice the minor differences in the respective terms, i.e., MATRIX (single terminal letter "X") versus MATRXXX (double letter "X"). Accordingly we find that the dominant portions of the respective marks are phonetically identical and are virtually identical in appearance.

Considered in their entireties as they must be, comparing opposer's marks MATRXXX MARKETING and MATRXXX MARKET WATCH with applicant's mark MATRIX ALLIANCES, we find the commercial impressions engendered by the respective parties' marks to be sufficiently similar that, when the marks are used in connection with legally identical services, confusion as to the origin or affiliation of the services is likely to occur.

Our conclusion that confusion is likely is strengthened by the fact that, on this record, there are no third parties utilizing marks, which are either identical or substantially similar to the marks at issue herein, in connection with telemarketing services.

Moreover, the record shows that opposer's revenue in 1997 was \$467 million, as reported in the annual report of Cincinnati Bell, Inc., then opposer's parent corporation. Given this significant level of revenue, and the recognition and strength developed therein through opposer's appreciable advertising and promotional expenditures between 1988 and 1998, the record reflects that opposer's MATRXXX marks have become relatively well

known as source indicators for opposer's services, and thus merits protection against imitation by applicant's MATRIX mark for legally identical services. See Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Applicant, as the newcomer, had the obligation to select a mark that would avoid confusion. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988). The more so in this case because it is well-established that one who adopts a mark similar to a strong mark of another for the same services does so at his own peril, and any doubt as to likelihood of confusion must be resolved against the newcomer and in favor of the senior user having a strong mark. W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976).

Decision: The opposition is sustained and registration to applicant is refused.